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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,212	02/04/2004	Brent D. Lien	F12. 12-0128	4250
27367	7590	06/07/2006	EXAMINER	
WESTMAN CHAMPLIN & KELLY, P.A. SUITE 1400 900 SECOND AVENUE SOUTH MINNEAPOLIS, MN 55402-3319			CAPUTO, LISA M	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/772,212

Applicant(s)

LIEN ET AL.

Examiner

Lisa M. Caputo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Amendment*

1. Receipt is acknowledged of the amendment filed 6 March 2006.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kabushiki Kaisha Toshiba (EP 0659588, from hereinafter "Kabushiki") in view of Piosenka et al. (U.S. Patent No. 4,993,068, from hereinafter "Piosenka").

Regarding claims 1, 28, and 41 Kabushiki teaches a system and method for producing an identification card (IC card body 131) that comprises the steps of retrieving ID information and forming an identification card print job defining an image

that includes the retrieved ID information arranged in accordance with a template (synthesized data printed on sheet with the common card pattern) (see Figures 1 and 6-7, abstract, col 7, lines 1-50).

Regarding claims 1, 28, and 41, Kabushiki fails to teach that an identification card is scanned to generate the ID data.

Piosenka teaches a system and method wherein a portable card containing physical characteristic information for a user is authorized by comparison to attributes entered at the authorization station. FIG. 1 depicts a block diagram of an authorization portion of the unforgeable personal identification system. The authorization portion or authorization site will include one or a limited number of sites that produce identification credentials. Identification credential generation requests and the appropriate data to form credentials may be gathered at these authorization sites. The information for forming these credentials may be provided to the authorization site from various remotely located information or data banks via electronic communication, mails or manually via input to the system. Trusted computer system 1 is the heart of the system. Trusted computer system 1 is connected to digitizing scanner 10 via an interface 20. Trusted computer system 1 is further connected to input camera 11 via interface 21, to retinal scanner 12 via interface 22, to fingerprint reader 13 via interface 23 and to voice print processor 14 via interface 24, and to pressure tablet 15 via interface 25. In addition, the remote access control site reads the encrypted identification credentials from the portable memory device (see Figure 1, col 3 line 65 to col 4 line 16).

In view of the teaching of Piosenka, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to employ the use of a card to obtain data instead of capturing all of the data manually again because it is more efficient (i.e. saves times since the process is not repeated). In addition, having the information on one card is favorable because it is a compact way of carrying information, and serves as a further step of authentication.

Regarding claims 2-5, 8-9, 29-31, 33, 46, and 49, Kabushiki teaches that the image is printed on a card substrate (therefore writing data to the substrate), and that the image does not necessarily match the identification card (i.e. it could be augmented and the locations of the ID information within the image are different from locations of the ID information on the identification card) (see col 7, lines 10-20 and col 10, lines 28-50).

Regarding claims 6 and 47, Kabushiki teaches that the ID information includes textual ID information and a photo, and that the photo contains the actual photo and textual ID information as well (see col 3, lines 25-45).

Regarding claims 7, 19, 25, 32, and 48, Kabushiki teaches that the textual information is selected from a group of conventionally known data (i.e. birth date, license number, etc.) (see Figure 3, col 1, lines 30-35, col 5, lines 42-50).

Regarding claims 10-11, 13-15, 27, 34-35, and 50-51, Kabushiki teaches that non-ID information (i.e. data common to all employees) can be added to the image (i.e. date, time, location, agreement, watermark, security mark in the form of the calculation formula, etc.) (see col 4, lines 8-10).

Regarding claims 12, 16, 36, and 52, Kabushiki teaches that the non-ID

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information can be retrieved from memory when it is taught that the data common to all of the employees can be located in the employee data which is stored in the data floppy disk 25 (see Figure 1, col 4, lines 5-15).

Regarding claims 17-18, 24, and 37, Kabushiki fails to teach that the retrieving step includes identifying a card format of the identification card, extracting the ID information from the ID data based upon the card format, and identifying elements of the ID information.

Piosenka teaches that a user 2 presents his credentials 4 to the credential reader 35. The credentials 3 were those prepared at the authorization site and reside in a credit card-type memory card or computer disc, etc. Credential reader 35 reads the identification medium and passes the composite data set to decryption function 42. The decryption function 42 utilizes one or more of the universal decryption variables (U.sub.d) and a particular mathematical algorithm to decrypt the data. Decryption function 42 then recovers the composite data set in unencrypted form. Since the universal decryption variable or key is published, many verification sites may use this decryption key (see Figure 2, col 8, lines 10-22). Hence, Piosenka teaches that the type of card being used is identified and further, that the ID information is extracted based upon the card format.

In view of the teaching of Piosenka, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the step of being able to identify the card format because if the card type is unknown, the information is not obtainable, hence the system will not run effectively.

Regarding claims 20 and 26, Kabushiki teaches that the method includes manually selecting individual textual identification information elements for insertion into the template when it is taught that the data editing computer 26 synthesizes desired image and employee data displayed and selected on the display unit and lays out the synthesized data to send to the printer 32 (see Figure 6, col 5, lines 22-28).

Regarding claims 21-23, 38-40, and 44-45, Kabushiki fails to teach that the scanning step includes optically scanning an identification card, reading a barcode on an identification card and reading a magnetic strip on an identification card.

Piosenka teaches that attribute information may be entered into the trusted computer system 1 via keyboard 50 or may be entered via digitizing scanner 10 through interface 20. Hard copy data may be input to digitizing scanner 10. Documentation may be presented to the digitizing scanner 10 for use in generating identity credentials of user 2, for example. Further, Piosenka discloses that some identification cards contain an additional magnetic strip which provides storage of digital data representing various information such as, employee number or security clearance level in a digital format (see Figure 1, col 1, lines 15-55, col 4, lines 48-54).

In view of the teaching of Piosenka, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the optical scanning of a barcode or information, or reading a magnetic stripe because these methods of obtaining data are standard methods utilized in many major transaction systems. Hence, a comprehensive, efficient, cost-effective system is obtained because the methods are conventional and work well to obtain information, with the added

advantage that there is limited extra costs to use these methods since they are standardized.

Regarding claims 42-43, Kabushiki teaches that there is an identification card printer adapted to print the image defined by the identification card print job on ink card substrates and that the scanner is formed integral with the identification card printer (see Figure 10, col 7, lines 43-50; col 8, lines 50-55).

### ***Response to Arguments***

4. Applicant's arguments filed 6 March 2006 have been fully considered but they are not persuasive.

5. In response to applicant's arguments that it is not possible for Kabushiki to disclose the "retrieving" and "forming" steps of the claims since they make use of the data retrieved during the non-disclosed card scanning step, examiner respectfully disagrees and submits that the Kabushiki reference does indeed teach that data is both retrieved and formed after the data is obtained via a different accessing/obtaining means (i.e. not scanning). Although the scanning of the data is not taught, there still exists data which is manipulated and it is obvious to replace one form of obtaining data with another (i.e. with the scanning of data from Piosenka) since it is well known in the art that there are many different, art recognized equivalent means to obtain data. It should be further mentioned that although examiner has referenced cited portions of the reference as teaching these elements, the entire reference should be taken as a whole when considering if they meet the claim limitations. Hence, applicant's arguments regarding the cited sections of Kabushiki and how they fail to disclose data retrieval are



moot.

In response to applicant's argument that Piosenka does not teach the missing limitation of scanning data, examiner respectfully disagrees and submits that hard copy data corresponding to a user is indeed scanned by a scanner 10.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, examiner utilized motivation well known in the art (and not from the applicant's disclosure) in order to make the rejection. For example, it is well known to be able to obtain data from a digital data card by scanning it, as is done with Piosenka. Further, it is obvious to modify Kabushiki with Piosenka, since Kabushiki already teaches a method of obtaining data. Hence, Kabushiki and Piosenka teach the limitations of the claims.

### ***Conclusion***

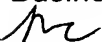
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Lisa M. Caputo** whose telephone number is (571) 272-2388. The examiner can normally be reached between the hours of 8:30AM to 5:00PM Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached at (571) 272-2398. The fax phone number for this Group is (571) 273-8300.

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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[lisa.caputo@uspto.gov]**.

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

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LMC

May 26, 2006



THIEN M. LE  
PRIMARY EXAMINER